

REMARKS

Upon entry of the present amendment, claims 24, 25, 27, 32, 33 and 37-41 are pending in the above-referenced patent application and are currently under examination. Claims 24, 25, 27, 32, 33, 38 and 39 have been amended. Claims 1-23, 26, 28-31 and 34-36 have been canceled. Claims 40 and 41 have been added. Reconsideration of the application is respectfully requested.

New independent claim 40 has been focuses the claims around the scope searched by the Examiner:

- The compound generic is now formula XI, which recites the fused azadecalin core.
- L¹ and L² recite a bond or unsubstituted alkylene.
- R¹ no longer recites cycloalkyl, aryl and heteroaryl. Similar amendments to R^{1A}, R^{1C} and R^{1D} have also been made.
- R² focuses on the scope of formula V where X is -S(O)₂- and ring J is phenyl. Moreover, R^{2G} no longer recites aryl and heteroaryl, but now recites cyano and trifluoromethyl. Support for the additions can be found throughout the specification, such as in the compounds of paragraphs 0308 and 0412 for the trifluoromethyl group, and the compounds of paragraphs 0314 and 0464 for the cyano group.
- R⁵ recites phenyl.

Moreover, all recitations of “substituted” have been removed from the claims.

New claim 41 recites species of the claims and finds support throughout the specification, such as in the compounds of paragraphs 0302, 0304, 0306, 0308, 0310, 0312, 0314, 0316, 0318, 0320, 0322, 0336, 0345, 0351, 0353, 0355, 0357, 0359, 0361, 0363, 0365, 0367, 0369, 0371, 0373, 0375, 0377, 0379, 0381, 0383, 0385, 0387, 0407, 0408, 0410, 0412, 0416, 0418, 0420, 0422, 0424, 0426, 0428, 0430, 0432, 0434, 0436, 0438, 0440, 0442, 0444, 0446, 0448, 0450, 0452, 0454, 0456, 0458, 0460, 0464, 0466, 0468, 0470, 0472, 0486, 0488, 0503, 0504, 0506, 0508, 0510, 0512, 0514, 0516, 0518, 0528, 0529, 0530, 0532, 0534 and 0537.

Claims 24, 25, 27, 32, 33, 38 and 39 have been amended to conform to new independent claim 40 and to amend the claim dependency in view of the claim cancellations.

Applicants believe the claim amendments add no new matter to the claims.

I. ENABLEMENT REJECTION

Claims 1, 3, 4, 8-28, and 32-39 have been rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

The test for enablement is whether the experimentation needed to practice the invention is undue or unreasonable (*Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916)) such that “the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention” (MPEP § 2164.01).

The Examiner alleges that the specification is enabling for substituents such as alkyl, halogen, cyano, alkoxy, CF₃ and alkylcycloalkyl, but does not reasonably provide enablement for any and all substituents on the R² phenyl or pyridine, or any other substituent on the R⁵ aryl. Applicants note that the claims have been amended as described above, and respectfully submit that the amended claims are enabled by the specification. Accordingly, Applicants respectfully request that this aspect of the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Alexander R. Trimble
Reg. No. 52,301

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
ART:art
62823301 v1